



IN THE

Supreme Court of the United States

OCTOBER TERM, 1941

No.

MASSACHUSETTS HAIR & FELT CO.,
Petitioner,

v.

B. F. STURTEVANT Company,
Respondent

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

THE OPINIONS OF THE COURTS BELOW

The master's report is found on pages 34-136 of Vol. I of the record. The opinion of the District Court is reported in 31 F. S. 975, and will be found at pages 164-8 of Vol. I of the record. The original opinion of the Circuit Court of Appeals is reported 122 F. (2d) 900. It will be found on pages 793-820 of Vol. III of the record. The

opinion of the Circuit Court of Appeals on rehearing and as amended thereafter is reported 124 F. (2d) 95, and will be found without amendment on pages 822-6 of Vol. III of the record, and the amendment thereto will be found on page 828 of Vol. III of the record.

JURISDICTION

The decree of the Circuit Court of Appeals was entered September 29, 1941 (R. V. III, p. 821) and the original opinion was filed the same day (R. V. III, p. 793). The petition for rehearing was denied November 21, 1941 (R. V. III, p. 826) and the opinion on rehearing was filed the same day (R. V. III, p. 822). This opinion was amended on motion for rehearing December 15, 1941 (R. V. III, p. 827). The statute giving jurisdiction is 240-A of the Judicial Code (28 U. S. Code § 347). The judgment was rendered in a suit in equity under the patent statute to determine validity of Letters Patent of inventions.

The cases believed to sustain jurisdiction are:

Lincoln Engineering Co. v. Stewart-Warner Corp.,
303 U. S. 545.

Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U. S. 477.

Cities Service v. Dunlap, 308 U. S. 208.

STATEMENT OF THE CASE

The foregoing petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ and a statement of the questions involved in the case.

SPECIFICATION OF ERRORS

The specification of errors relied upon are those reasons set forth in the petition for the writ as grounds for its allowance.

THE ISSUES

The issues relate to extension of monopoly.

The first issue is whether an inventor, who has improved one element of an old combination, has any valid enforceable right in a patent in which he claims the old combination with the improved element substituted for the old element of the old combination.

The second issue is whether a patentee who has patented an invention may later obtain a second patent for the invention of the first patent with unpatentable additions, merely because the application for the second patent was co-pending with the application for the first patent.

SUMMARY OF ARGUMENT

Point 1. The decision of the Circuit Court of Appeals for the First Circuit is in conflict with decisions of this Court which prohibit the extension of monopoly in that the Court sustained combination claims, although it found that the invention lay in improving one element only of the combination which was old.

Point 2. The Circuit Court of Appeals for the First Circuit has held that an inventor who has improved one element of an old combination and has patented the old combination with the improved element has a valid enforceable right under certain circumstances. This holding is untenable.

Point 3. The Circuit Court of Appeals for the First Circuit has held that an inventor who has obtained a patent for his invention may obtain a second and later patent, relying upon the same inventive concept by merely making unpatentable additions to the invention of his first patent, merely because the applications for the patents were co-pending. This holding is untenable.

ARGUMENT

POINT 1: The decision of the Circuit Court of Appeals for the First Circuit is in conflict with decisions of this Court which prohibit the extension of monopoly in that the Court sustained combination claims, although it found that the invention lay in improving one element only of the combination which was old.

There is an impressive array of findings in this case that Hagen did not invent the combination of a centrifugal fan, a constant speed motor and vanes in the inlet to control spin and vary output. The following findings of the master, which culminated in the finding

“The advance of Claim 2, therefore, resides in the design and arrangement of vanes” (R. V. I, p. 111)

which was quoted with approval by the Court of Appeals (R. V. III, p. 811) are very clear and unequivocal.

“Hagen does not claim to have discovered the principle of spin control of a fan impeller. Nor does he claim to have invented broadly the method of or an apparatus for producing and varying the spin component of the entering air of a fan by an arrangement of adjustable vanes at the eye or inlet” (R. V. I, p. 55).

“In my judgment, Eickhoff shows and describes vanes surrounding a pump or fan inlet, which vanes are adjustable to increase or decrease the spin component of the fluid from maximum to minimum as means for controlling output, and that he describes the use of such vane adjustment for this purpose” (R. V. I, p. 81).

“Hagen does not claim to have discovered or developed the principle of control of fan output

at constant speed by the use of vanes at the inlet, adjustable to supply and control spin component" (R. V. I, p. 105).

"There is no novelty in the first portion of claim 2, through the provision for vanes which are adjustable to vary the output. A constant speed rotor with an inlet and a plurality of vanes therein, forming passages to admit fluid to the rotor with a spin component, the vanes being adjustable to vary the output, was old, and I do not understand that plaintiff contends otherwise. If there is patentable novelty in claim 2, it resides in the provision for vanes adjustable through the range from maximum to minimum capacity with a substantially tangential admission, the vanes having adjacent surfaces continuously approaching parallelism, etc., as specified in the last half of the claim" (R. V. I, p. 110-1).

The only distinction which the Courts below could find to distinguish the prior art were distinctions in vane design or arrangement with reference to the extent of adjustability. Eickhoff was distinguished because the vanes were flat instead of curved. Moody was distinguished because the vanes might be streamlined and might not be arranged for the wide range of adjustability. Beaudrey was distinguished because the vanes were streamlined. Brown, Boveri was distinguished because the vanes did not have the range of movement and were not shown in great detail.

The most that could be said for Hagen was that he had created an improvement in vanes so that they would give more efficient, definite, predictable and better control than the vanes that had been used before in the same combination. It is no wonder that the Court of Appeals found in its first opinion that Hagen's contribution was a mechanism for controlling the output of a centrifugal fan by vanes (R. V. II, p. 812) and later, on rehearing stated, in the

portion of the opinion which was stricken on second re-hearing (R. V. III, p. 824):

"The plaintiff in the case at bar admits that 'Centrifugal fans are very old, and adjustable inlet vanes are not new'. In view of this admission, which is in accordance with the testimony in the record, and of the master's finding that there is no novelty in the first portion of this claim since 'A constant speed rotor with an inlet and a plurality of vanes therein, forming passages to admit fluid to the rotor with a spin component, the vanes being adjustable to vary the output, was old, and I do not understand that plaintiff contends otherwise,' we are of the view that the claim under consideration should not be construed as a combination claim but as an improvement one only. That is, that it should be construed as a claim only for vanes of a particular form arranged in the inlet in a particular way to produce a result asserted to be new and useful, not as a claim for those vanes plus a constant speed centrifugal fan with vanes in its inlet."

All that Hagen did was add his particular vanes with their particular arrangement with respect to adjustability to the old combination on which the patents had expired. The only new result he could claim was a more efficient, definite, predictable and better control than the prior art vanes gave. The motor drove the fan just as it always had. The fan moved the air through the casing, just as it always had. The vanes controlled spin broadly, just as they always had to control output, but they were more efficient vanes when they embodied Hagen's design.

A patentee cannot by improving one element of an old combination, whose construction and operation is otherwise unchanged, extend the monopoly on the combination and patent it again with the improved element in place of the old one.

In *Bassick Mfg. Co. v. Hollingshead Co.*, 298 U. S. 415, this Court said:

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler, and a grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such (No. 1,307,733). Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler (No. 1,307,734, the patent in suit; claims 1-6, 8 and 10). He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art (Claims 14 and 15). The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation are otherwise unchanged, may, in effect, repatent the old combination by reclaimsing it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts" (p. 424).

In *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, this Court said:

"The invention, if any, which Butler made was an improvement in what he styles in his specifications the 'chuck' and in his claim a 'coupling member'. It is not denied that multi-jawed chucks had been used in industry and as couplers in lubricating apparatus. Butler may have devised a patentable improvement in such a chuck in the respect that the multiple jaws in his device are closed over the nipple by the pressure of the grease, but we think

he did no more than this. As we said of Gullborg in the Rogers Case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in his claimed combination. The patent is therefore void as claiming more than the applicant invented" (p. 549).

"The function of a pump has always been to force a fluid or a grease through a conduit. The fact that this function of the pump is utilized in Butler's improved form of coupler not only to convey the lubricant to the bearing but to operate the jaws of the chuck does not alter the function of the pump. The invention, if any, lies in the improvement in the coupling device alone" (p. 551).

Petitioner's position is that these cases are clearly in point. In both of them, the invention, if any, resides in improving one element of the old combination, a situation which the record and findings clearly establish in the present case. In both of them the claims were in the same form as Claim 2 of the first Hagen patent, where the claim starts out "The combination with".

The Court of Appeals had no trouble in seeing that the record clearly establishes that Hagen's invention, if any, was in the design of the vanes and it so found. When the matter came up on rehearing, the Court still saw that the record establishes that Hagen's invention was merely an improvement in vanes and the Court so found, but sought to avoid the effect of the *Bassick* and *Lincoln* cases by construing the claims as covering merely improvements in vanes (R. V. III, p. 824).

When it was called to the Court's attention on the second rehearing that the *Lincoln* and *Bassick* cases could not be so easily avoided, the Court construed the *Lincoln* and *Bassick* cases as applying only if a patentee sought to

prevent others from using any form of vane control and held that since the patentee was merely attempting to keep petitioner from using the specific form of vanes with a fan, the question thus presented is whether or not the new element caused the combination to produce a new and useful result, not merely the aggregate of several results.

It is difficult to follow this line of reasoning. The fact remains that the Court did not dispose of the clearly established fact that the combination was old and that Hagen had merely improved the vanes. The mere fact that the improved vanes made the old combination better did not make the old combination with the improved element patentable as a combination. In every case where an element is improved, the combination works better. Otherwise one could not say the element was improved. In the present case, the function of the motor remains unchanged. The function of the fan remains unchanged. Any improvement in the result flows from the improvement in vanes and not from any new coacting relationship.

The Court of Appeals and the District Court and the Master have all found that the combination was old and that the invention resides in the design of the vanes. Claim 2 of the patent claims the old combination with the vanes of new design in place of the old vanes. Under the *Bassick* and *Lincoln* decisions, such claims extend the monopoly and are invalid.

In the present case, the respondent was licensed under the Moody patent and was manufacturing under the license. It brought suit against petitioner on the Moody patent but dropped the suit, apparently because it preferred to have the extended monopoly of the Hagen patents which cover the same combination as Moody with the addition of the improvement in vanes (R. V. I, p. 409).

The above comments have been directed specifically to Claim 2 of the first Hagen patent, but they apply with equal force to the second Hagen patent, the claims of which are not directed merely to improved vanes, but are directed to a combination consisting of the fan, its rotor, its casing, the conical inlet passage and the vanes (R. V. II, p. 588). The Court of Appeals should have applied the rule of the *Lincoln* and *Bassick* cases to the second as well as the first Hagen patent.

The present case is a flagrant one of extension of monopoly. The failure of the Court of Appeals to follow the rule against extension of monopoly was erroneous. This constitutes grounds for certiorari.

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POINT 2: The Circuit Court of Appeals for the First Circuit has held that an inventor who has improved one element of an old combination and has patented the old combination with the improved element has a valid enforceable right under certain circumstances. This holding is untenable.

When the Court of Appeals finally amended its opinion in the second rehearing, it construed the *Lincoln* and *Bassick* cases as holding that an inventor, who has improved one element of an old combination and who has claimed the old combination with the improved element, may enforce his patent against one who uses the old combination with the improved element. The Court stated that the *Lincoln* and *Bassick* cases do not apply except when the inventor seeks to keep others from using the old combination in every form (R. V. III, p. 828).

It is believed that this is a misinterpretation of these cases. It is true that in each of these cases the patentee was seeking to hold a contributory infringer who was supplying elements of the combination, knowing they were to be used in infringement of the patent.

It may be that it was the intention of this Court to hold that the rule of the *Lincoln* and *Bassick* cases applies only to such situations. If that is the case, this Court should clarify its holding.

We believe that the Court of Appeals has misconstrued the cases and that this Court intended them to apply to a situation in which the patentee has, by his claims, extended the monopoly on the old combination. We believe that this Court intended to have the cases apply to every such patent, regardless of what the patentee attempts.

If the situation created by the Court of Appeals decision is not corrected, other courts may conclude that the ruling of the *Bassick* and *Lincoln* cases is merely a limited one. Other courts may take the view that a patentee may extend the monopoly on an old combination if he is careful to enforce his patent only against direct rather than contributory infringers.

We submit that under the circumstances, this Court should grant certiorari either to clarify its ruling in the *Bassick* and *Lincoln* cases or to correct the action of the Court of Appeals in failing to follow the rulings.

POINT 3: The Circuit Court of Appeals for the First Circuit has held that an inventor who has obtained a patent for his invention may obtain a second and later patent, relying upon the same inventive concept by merely making unpatentable additions to the invention of his first patent, merely because the applications for the patents were co-pending. This holding is untenable.

The District Court and the Master held the second Hagen patent invalid. They saw that the respondent was merely seeking an extension of the monopoly of the first patent and they refused to permit this.

The District Court and the Master held that the claims of the second Hagen patent define no invention over Hagen's first patent in view of the prior art, in particular the Moody patent.

The Moody patent discloses the conical inlet and the vanes pivoted on axes oblique to the rotor axis and at right angles to the inlet defined by the claims of the second Hagen patent. The respondent contended, however, that Moody did not disclose the wide range of adjustment from maximum to minimum, or vanes which would direct the entering gas to the rotor with a spin throughout their adjustment. In other words, respondent contended that Moody was not an anticipation because it did not have the inventive concept on which the first patent was based, namely the wide range of control and the vanes designed to efficiently control spin.

The District Court and the Master saw that the respondent was seeking two patents based upon the same inventive concept, the first one covering broadly all vanes such as those shown in both Hagen patents, and the second one, through unpatentable additions taken from

Moody, covering the same invention in a more limited field.

The District Court did not question the finding that there was no invention over Hagen's first patent in view of the prior art. It is obvious that this conclusion is correct. The Court of Appeals, however, took the view that this was not enough to invalidate the second Hagen patent because its application was co-pending with the application for the first Hagen patent.

There is a large body of authority sustaining the position taken by the District Court and the Master.

In re Byck, 48 F. (2d) 665
In re Robinson, 48 F. (2d) 931
In re Peiler, 56 F. (2d) 878
In re Mason, 62 F. (2d) 185
In re Gollmar, 67 F. (2d) 907
In re Neuberth, 82 F. (2d) 718
Bissell Carpet Sweeper Co. v. Coe, 82 F. (2d)
821
In re James, 83 F. (2d) 313
Oates v. Camp, 83 F. (2d) 111
In re Seebach 88 F. (2d) 722
In re Barge, 96 F. (2d) 314
In re Bertsch, 107 F. (2d) 828
In re Land, 109 F. (2d) 246
In re Land, 109 F. (2d) 251

These cases are primarily cases decided by the Court of Customs and Patent Appeals. They hold that if a patentee has made an invention and has obtained a patent therefor, he has received his reward and has exhausted his rights and that he cannot, by merely adding unpatentable subject matter to the invention, obtain an extension of his monopoly. They hold that there must be more than one invention for more than one patent.

These cases are well reasoned ones. If an inventor makes an invention, he is entitled to the 17 year monopoly. If his invention is broad enough to cover several fields or several modifications, he is entitled to the 17 year monopoly in these fields. He is not, however, entitled to obtain broad protection for all fields or modifications of his invention and obtain a patent therefor and then later obtain another patent for the same invention by merely adding unpatentable features to it and thus limiting it to a specific field or modification. If he can do this, he obtains a monopoly longer than the 17 years prescribed by law.

The situation in the present case is a good illustration of the soundness of the rule. The first Hagen patent is broad enough to cover the petitioner's structure. It granted a monopoly from February 23, 1932 to February 23, 1949. The second Hagen patent grants a monopoly covering the same structure from January 29, 1935 to January 29, 1952. The total monopoly is thus nearly 20 years and not merely 17, yet the inventor has contributed only one inventive concept.

The decision of the Court of Appeals is based upon *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 22 F. (2d) 259, which holds that if patent applications are co-pending, the second need not cover a patentable advance over the first.

There is a definite clash of authority here. The Court of Customs and Patent Appeals, which governs proceedings in the Patent Office, has established its rule that there must be a patentable distinction if there are to be two patents. These decisions affect the right of inventors in all parts of the country. If they are wrong, they should be corrected.

We submit that these decisions of the Court of Customs and Patent Appeals state the preferable rule. They prevent extension of monopoly. They keep an inventor from obtaining two patents which are not inventively different and keep him from thus monopolizing a field more than the 17 years provided by law.

It is not too much to require of an inventor that he confine himself to a single patent for a single invention. If he is required to do so, he has his full recompense and the members of the public are protected against extension of monopoly such as that involved here.

In the present case, the same inventive concept forms the basis for both patents. The second patent defines nothing inventive over what is claimed in the first patent. If both patents are held valid the respondent will have a 20 year monopoly instead of a 17 year one for his single inventive concept.

There is no conflict between decisions of Courts of Appeals involving the specific patents involved here, but there is a conflict between the Master and the District Court on one hand and the Court of Appeals on the other hand on a point of law which has not been settled by this Court and which should be settled by it.

CONCLUSION

Wherefore, petitioner earnestly prays that the petition for writ of certiorari be granted, the case be reviewed, and the decree of the Court of Appeals for the First Circuit, finding validity for Claim 2 of Hagen patent 1,846,863 and for all claims of Hagen patent 1,989,413 be reversed.

Respectfully submitted,

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